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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/073,717

02/11/2002

Dean M. Willard

PIA-10302/04

5678

68837 7590 02/17/2009  
GIFFORD, KRASS, SPRINKLE, ANDERSON et. al.  
2701 TROY CENTER DRIVE  
STE. 330  
TROY, MI 48007

EXAMINER

HANDY, DWAYNE K

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

02/17/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/073,717	<b>Applicant(s)</b> WILLARD ET AL.	
	<b>Examiner</b> DWAYNE K. HANDY	<b>Art Unit</b> 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 7,8,10,11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,9 and 12-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-16 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/22/08 has been entered.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-4, 6, 9, 12 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Mainwaring et al. (6,779,657). This rejection was maintained in the previous Office Action (mailed 8/6/08). It remains in effect. Please see Response to Arguments below.

***Inventorship***

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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6. Claims 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mainwaring et al. (6,779,657) in view of Boeder (4,373,077). This rejection was maintained in the previous Office Action (mailed 8/06/08). It remains in effect. Please Response to Arguments below.

7. Claims 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mainwaring et al. (6,779,657) in view of Spinu et al. (5,210,108). This rejection was maintained in the previous Office Action (mailed 8/06/08). It remains in effect. Please Response to Arguments below.

***Response to Arguments***

8. Applicant's arguments filed 12/22/08 have been fully considered but they are not persuasive. Applicant has argued that Mainwaring fails to suggest or teach a package "having a pouch adapted to enclose said applicator said package peelable to expose the applicator while shielding the same from user contact" (Applicant's arguments, pages 5-6). The Examiner respectfully disagrees and notes that Mainwaring teaches that their package can be formed through affixing the cover (26) to the tray (10) by an adhesive, ultrasonic welding, solvent welding, heat sealing and the like in column 7, lines 1-10. Applicant teaches the same methods to seal their package in the Specification at page 7, lines 12-18. Mainwaring additionally teaches that the package may be opened such that either the cover or tray is facing upward (column 7, lines 15-

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19). For these reasons, the Examiner submits Mainwaring teaches a cover and tray that meets the limitation of a “peelable” package.

The Examiner submits that using the package to shield the applicator from the user is an intended use of the package. The package of Mainwaring is capable of meeting this limitation. A user who peels the cover (26) off so that it remains above the exposed pre-moistened portion of the applicator (20) as shown in Figure 1 would be “shielding” the pre-moistened applicator from contact with the user. This is still true even if the user is grasping the handle portion of the swab while the cover or tray is removed (as argued by Applicant on page 6). Therefore, the package is “peelable to expose a pre-moistened applicator while shielding the same from user contact” as required by the claim as written.

9. Applicant has also argued that Mainwaring does not teach an applicator that is attached to the package (Applicant’s arguments, pages 5-6). The Examiner again respectfully disagrees. Mainwaring teaches a retainer (16) that is comprised of a narrowed portion of the passageway (14) and positioned to contact the handle portion (20A) such that it prevents unintentional removal of the applicator (column 6, lines 42-55). The Examiner considers the friction fit between the retainer and handle to be an attachment between the two.

10. Applicant has argued that one of ordinary skill in the art would not be motivated to combine the teachings of Boeder with Mainwaring. Applicant has also noted that the

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Exemplary Rationale used by the Examiner for the 103 rejection appears to be Exemplary Rationale “(A) Combining Prior Art Elements According to Known Methods To Yield Predictable Results” (Applicant’s Arguments, pages 12-13). The Examiner submits that an additional rationale – “(B) Simple Substitution of One Known Element for Another to Obtain Predictable Results” may also be used in addition to rationale (A).

The rejection in general is as follows:

Mainwaring teaches a product comprised of an applicator, polymerizable adhesive and an initiator (column 22, line 51 – column 24, line 35) – but does not teach initiators comprised of copper compounds. The product of Mainwaring may be used to seal and/or bond surfaces of substrates such as metals, wood, plastics, rubbers, wood, ceramics, fabrics, cement, paper, living tissue and the like (column 20, lines 13-19). Boeder also teaches a product comprised of an applicator, polymerizable adhesive and an initiator. Boeder also teaches that their product may also be used to bond metals and wood (column 3, lines 1-8 and column 7, lines 50-68). In the passage from column 7 cited by the Examiner, Boeder notes that when relatively inactive metals or non-metal substrates are to be bonded, it is often desirable or perhaps even necessary to include an activator. The preferred activator is copper acetylacetonate.

11. The Examiner’s explanation of the rejection with respect to Exemplary Rationale “A” is as follows:

The prior art includes each element claimed (package, applicator, copper initiator) although not in a single prior art reference. The only difference between the

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claimed invention and the prior art is the lack of actual combination of the elements in a single prior art reference.

One of ordinary skill in the art could have combined the elements as claimed by known methods (both references teach the incorporation of activators/initiators in the package) and that the copper activator from Boeder would perform the same function in the combination.

One of ordinary skill would have recognized that the resulting combination was predictable given the cited teachings from Boeder as to how the copper activator is used with their device to assist in bonding non-active substrates.

Finally, the Examiner submits that the reason to use the copper activator is clearly articulated by the Boeder reference in columns 7 and 8: "...when the compositions of the present invention are to be employed in bonding operations involving relatively inactive metals or non-metal substrates or combinations thereof, it is often desirable to include an appropriate activator which is preapplied to at least one of the surfaces. Such an activator can, of course, be employed to further accelerate cure when active metal surfaces are involved in the bonding operation. Particularly suitable activators include compounds containing transition metal ions, examples of such activators including iron acetylacetonate, vanadium actylacetonate and copper octoate. A preferred activator of this type is copper acetylacetonate".

12. The Examiner's explanation of the rejection with respect to Exemplary Rationale "B" is as follows:

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The prior art contained a device (Mainwaring) which differed from the claimed device by the substitution of a component (the copper activator).

The substituted component and its function (as an activator for relatively inactive substrates to be bonded) were known in the art (taught in Boeder).

One of ordinary skill in the art could have substituted one known element (copper activator for non-copper activator) and the results of the substitution would have been predictable. The predictable result would be a product for delivering adhesive that includes an activator that helps in bonding non-metal substrates.

### ***Conclusion***

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DWAYNE K. HANDY whose telephone number is (571)272-1259. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dwayne K Handy/  
Examiner, Art Unit 1797

/Jill Warden/  
Supervisory Patent Examiner, Art Unit 1797

February 10, 2009